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REMARKS

Reconsideration of the present application and entry of the following remarks is respectfully requested. Claims 2 to 7, 9 to 14, 16 to 19 and 21 to 23 are currently pending, and no claims have been amended.

The Office Action mailed March 9, 2004 addressed claims 2 to 7, 9 to 14, 16 to 19 and 21 to 23. Claims 2 to 7, 9 to 14, 16 to 19 and 21 to 23 were rejected.

Claims 2 to 7, 9 to 14 and 16 to 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraoka et al. (Re 35,293). The Examiner stated that regarding claim 2, Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A), which may be BUNA CB 10. The Examiner further stated that the COR value is an obvious feature since the polybutadiene is identical to Applicant's. The Examiner further stated that regarding claim 3, Applicant appears to be claiming a method of production that is not relevant to the final product, however any properties based on the polybutadiene are obvious since Applicant's is identical to Hiraoka; regarding claim 4, Hiraoka discloses a Mooney viscosity range of 45 to 90 and Applicant discloses BUNA CB 10 has a Mooney viscosity of 47 ± 5 ; regarding claim 5, the golf ball includes a cover; regarding claim 6, the polybutadiene has a cis 1-4 content of 80% or more; regarding claim 7, the core composition includes a second polybutadiene (B); regarding claim 9, the COR value is an obvious feature since the polybutadiene is identical to Applicant's; regarding claim 10, Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A), which may be BUNA CB 10; regarding claim 11, the polybutadiene has a cis 1-4 content of 80% or more; regarding claim 12, Applicant appears to be claiming a method of production that is not relevant to the final product, however any properties based on the polybutadiene are obvious since Applicant's is identical to Hiraoka; regarding claim 13, the core composition includes a second polybutadiene (B); regarding claim 14, Hiraoka discloses a Mooney viscosity range of 45 to 90 and Applicant discloses BUNA CB 10 has a Mooney viscosity of 47 ± 5 ; regarding claims 16 and 17, Hiraoka discloses the method of making a golf ball including selecting BUNA CB 10 for the core material and molding the core composition, and the performance features of the core are obvious since the material is identical to Applicant's; regarding claim 18, the features of the polybutadiene are obvious since the

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material is identical to Applicant's; and regarding claim 19, Hiraoka discloses a Mooney viscosity range of 45 to 90 and Applicant discloses BUNA CB 10 has a Mooney viscosity of 47 ± 5 . The Examiner concluded that although Hiraoka does not disclose the COR, the feature is considered obvious since the first polybutadiene disclosed by Applicant is identical to the polybutadiene disclosed by Hiraoka.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. Hiraoka et al. discloses a golf ball comprising a core wherein the core comprises a mixture of (A) a solid polybutadiene rubber and (B) a liquid polybutadiene or a liquid isoprene-butadiene rubber or both. Hiraoka et al. discloses that the improvement is the addition of (B) to improve processability. Hiraoka et al. does not disclose the COR of the golf ball core.

The Examiner stated that "Hiraoka et al. discloses a core made from BUNA CB 10 (poly A) and an additional rubber, wherein the BUNA CB 10 is present in the amount of 98 parts (col. 2). Therefore, it is clear the COR would obviously be the same, 0.786." (Page 5 of Office Action of March 9, 2004) Applicant respectfully submits that the COR would not "obviously be the same" as Applicant's because Hiraoka is not using the same materials. Hiraoka does not show any COR values at all, nor does Hiraoka make any actual examples using BUNA CB 10 as the polybutadiene (A). Applicant respectfully submits that adding even a small amount of liquid polybutadiene rubber or liquid isoprene-butadiene rubber would improve the processability of the rubber, as stated by Hiraoka, but it would also lower the COR of the core. Hiraoka has chosen one of a number of polybutadiene rubbers to blend with a liquid rubber, but Hiraoka fails to recognize that using a polybutadiene having a particular solution viscosity value will improve the COR value of the core. As previously stated, Hiraoka does not even measure, or at least disclose, the COR of the core of his golf balls.

Applicant respectfully submits that the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the prior art. Inherency must be a necessary result and not merely a possible result. Applicant respectfully submits that the Examiner has failed to support the inherency determination with any facts or technical

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reasoning, but instead, is attempting to shift the burden to Applicant to prove that it would not be inherent.

For at least these reasons, Applicant respectfully submits that the rejection of claims 2 to 7, 9 to 14 and 16 to 19 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 2 to 7, 9 to 14 and 16 to 19 be reconsidered and withdrawn.

Claims 21 to 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraoka et al. (Re 35,293) in view of Cadorniga et al. (US 5,508,350). The Examiner stated that Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A) and a second polybutadiene (B), and Hiraoka further discloses up to 25% of the second polybutadiene but does not disclose the range claimed by Applicant. The Examiner concluded that Cadorniga teaches 50% of two different polybutadienes in a golf ball core, therefore one of ordinary skill in the art would have increased the quantity of the second polybutadiene to achieve the desired properties of the core.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. As discussed above, Applicant respectfully submits that Hiraoka et al. does not disclose Applicant's invention. The addition of Cadorniga et al. also does not cure the deficiency of Hiraoka et al.; that is, Cadorniga et al. also does not disclose a golf ball core with Applicant's claimed properties. Additionally, Cadorniga et al. only discloses a blend of 50% each of two different polybutadienes. Applicant respectfully submits that Cadorniga et al. does not provide any motivation or suggestion to increase the amount of the second polybutadiene to Applicant's claimed range because Cadorniga et al. only teaches a 50/50 blend. Additionally, Applicant respectfully submits that there is no motivation or suggestion to combine Cadorniga et al. with Hiraoka et al. because Cadorniga teaches away from Hiraoka et al. Hiraoka et al. teaches that more than 25% of a second liquid polybutadiene or isoprene-butadiene makes processability poor, while Cadorniga teaches a 50/50 blend as the preferred embodiment for a blend of two high cis polybutadiene rubbers. Finally, Applicant respectfully submits that the combination of Hiraoka et al. also does not disclose Applicant's invention because Cadorniga et al. does not disclose a golf ball having a core formed of a polybutadiene

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having a particular solution viscosity and a particular COR, in combination with a second polybutadiene comprising from 30% to 50% by weight.

For at least these reasons, Applicant respectfully submits that the rejection of claims 21 to 23 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 21 to 23 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 2 to 7, 9 to 14, 16 to 19 and 21 to 23. Applicant respectfully requests allowance of claims 2 to 7, 9 to 14, 16 to 19 and 21 to 23, the claims currently pending.

Respectfully submitted,

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